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Commissioner for Patents
Washington, D.C. 20231

On: January 17, 2003


Kendyl A. Roman

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PATENT APPLICATION 09/312,922

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:	Figuredo et al.	Art Unit:	2613
Appl. No.:	09/312,922	Examiner:	Charles Parsons
Filed:	05/17/99		

Title: System for Transmitting Video Images Over a Computer Network to a Remote Receiver

Commissioner for Patents
Washington, D.C. 20231

VOLUNTARY AMENDMENT

Sir:

Please amend the application identified above as follows:

IN THE LIST OF INVENTORS:

Please amend the list inventors to match the original order as filed in the provisional patent application (06/085,818, filed May 18, 1998). The original filing receipt is attached. The corrected order is:

Kendyl A. Roman \

R. Paul Raposo \

Richard Scott Neale \

Cyrus Java Hoomani \

Vince Michael Figuredo, Dr. \



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Roman, et. al.

Art Unit: 2613

Appl. No.: 09/312,922

Examiner: Charles Parsons

Filed: 05/17/99

Title: System for Transmitting Video Images Over a Computer Network to a Remote Receiver

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RESPONSE TO ELECTION REQUIREMENT

Sir:

In response to the restriction requirement dated December 17, 2002, applicants hereby

- a) cancel the Group III claims (28-31), and
- b) provisionally elect the Group I claims (1-7, 17-22, and 23-27), with traverse of Group II claims (8-16) as set forth below.

The office action did not specifically address claim 27, which is dependent on claim 23.

Applicants submit that claim 27 should be included in Group I.

Please also be advised that the Group III claims (28-31) have been effectively transferred to co-pending application 09/470,566 (filed 12/22/99) in an amendment filed January 13, 2003 in the same art group (Behrooz Senfi examiner, Chris Kelley supervisor).

A restriction requirement to one of two or more claimed inventions is proper only if the claims are able to support separate patents and they are either "independent" or "distinct." In this case, the office action has alleged that the two *remaining* groups of claims (Group I = claims 1-7, 17-22, and 23-27 and Group II = claims 8-16) are "distinct" for the following reasons:

- a) "The combination as claimed does not require the particulars of the subcombination as claimed because any compression scheme would apply to the invention claimed in the Group I claims."

- b) “The subcombination has separate utility such that they can be used in any video compression system.”

However, applicants respectfully disagree and submit that the office action has failed to make a proper case for restriction regarding Group I and II. The applicant therefore requests that the Examiner reconsider and withdraw the restriction requirement. The applicant also notes that the office action has not alleged that the two remaining groups of claims are “independent.”

MPEP §802.01 defines the term “distinct” as follows:

The term "distinct" means that two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (though they may each be unpatentable because of the prior art). It will be noted that in this definition the term related is used as an alternative for dependent in referring to subjects other than independent subjects.

First, the office action has not clearly identified the requisite relationship between the two remaining groups of claims (Groups I and II). Both of the remaining groups are combinations with claims covering similar combinations of elements. Applicants submit that such a relationship (i.e. combination/subcombination or genus/species) cannot be identified between Group I and II, because there is none.

Second, it is not clear to applicants that the two groups of claims could support separate patents. For example, claim 22 (in Group I) and claim 16 (in Group II) are very similar in scope, and would not appear to be patentably distinct.

Third, the office action asserts that the Group II claims require “line and repeat generation”, which is not required in the Group I claims. The office actions states, “any compression scheme would apply to the invention claimed in the Group I claims”. However, applicants note that claim 17 specifically recites “forming a compressed data stream including one or more line number data structures and one or more repeat data structures” contrary to the office action’s assertion.

Fourth, the office action states that the Group I claims “are drawn to a broad video transmitting device”, whereas the Group II claims more limited. However, applicants note that claim 17 (although worded slightly differently) specifically describes a system comprising:

- a) a transmitter
- b) a compression device for forming line and repeat data structures
- c) a remote receiver
- d) a decompression device

as in claim 10. Thus, although claim 10 presents a broader statement of the invention than claim 17, both groups of claims are directed to the same subject matter.

Lastly, there is no showing that the lack of the restriction would place a serious burden on the Examiner since both Group I and II contain claims of similar scope and would require a similar search.

In sum, applicants submit that the Office action has not made an adequate showing that the two remaining groups of claims are distinct. The two remaining groups of claims are not related as combination and subcombination, or as genus and species, or any of the other patterns of relatedness discussed in MPEP §§ 806 et. seq.

For all the foregoing reasons, applicant respectfully traverses the restriction requirement (regarding Group I and II) and requests that the Examiner withdraw the same.

Respectfully submitted,

Dated: January 17, 2003



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